

REMARKS

Claims 1-62 are pending in the application. Claims 1-44 and 54-62 have been withdrawn. Claims 45-53 have been rejected. In response, independent Claim 45 has been amended. In addition, new dependent Claims 63-70 have been added. No new matter has been added. Support for the peel adhesion strength in new Claims 63-68 is found in original Claims 1-12. Support for the materials recited in new Claim 69 is found in Paragraph 0033. Support for the arcuate configuration recited Claim 70 is found in Paragraph 0014 of the application, as well as the Figures.

A. Election/Restriction

In paragraphs 1-6 of the Office Action, the Examiner separated the claims into four inventions: Group I, Claims 1-38 drawn to a stack of flexible sheets; Group II, Claims 39-44, drawn to a method of using a stack of flexible sheets as an animation flip pad; Group III, Claims 45-53, drawn to a method of using a stack of flexible sheets as recreational toy; and Group IV, Claims 54-62, drawn to an expandable recreational toy. Applicant hereby confirms election the invention of Group III, Claims 45-53 for prosecution on the merits in the above-identified application. Applicant reserves the right to continue the prosecution of the non-elected inventions in one or more separately filed divisional patents without prejudice or disclaimer.

B. Claim Rejections Under Section 103

In paragraphs 7-8 of the Office Action, the Examiner rejected Claims 45-47 under 35 U.S.C. § 103 as being obvious over Kaye, U.S. Patent No. 5,390,819 ("the Kaye '819 Patent"). In paragraph 9, the Examiner rejected Claims 48-53 under 35 U.S.C. § 103 as being obvious based on the Kaye '819 Patent in view of James, U.S. Patent No. 2,415,012 ("the James '012 Patent"). Applicant respectfully traverses the rejection in light of the amended claims.

The Examiner states that the Kaye '819 Patent teaches using a stack of flexible sheets as a toy. Applicant respectfully disagrees. The stack of flexible sheets disclosed in Kaye '819 Patent are used solely in combination with a **dispenser** that houses the sheets. As such, it is not possible to use the stack of flexible sheets as a toy. See, e.g., column 1, lines 50-55 ("It is a principal object of the invention to improve upon the adhesive placement in the stacks of sheets described in the above-identified prior art patent so that as each successive sheet is withdrawn **through a dispenser slot** and peeled away from the next sheet the advancing line of separation between its adhesive-coated area and the next sheet becomes progressively shorter until reducing to a point upon complete separation."); Claim 1 ("stack of flexible polygonal sheets in combination with **a dispenser** disposed over one another..."). Indeed, the Kaye '819 Patent repeatedly emphasizes the "ultimate object is to improve the ability of the separated sheets to lie flat during use" (column 1, lines 61-63) – again a configuration that precludes use as a recreational toy as claimed.

In rejecting the claims, the Examiner relies primarily on FIGS. 4 and 6 of the Kaye '819 Patent. These figures illustrate how the adhesive of the prior art (FIG. 4 – adhesive on the edges) and Kaye '819 Patent (FIG. 6 – adhesive on the corners) differ in terms of the location of the adhesive. The sheets were drawn with the sheets expanded because the location of the adhesive could not be shown when the sheets are stacked for use in the dispenser as shown in FIG. 5. Thus, FIGS. 4 and 6 do not teach using the stack of flexible sheets as a recreational toy. Further, the figures do not teach the step of spreading the stack of flexible sheets in a semi-circular or arcuate form as claimed in dependent Claim 70.

Further, there is nothing in the Kaye '819 Patent to teach or suggest the peel adhesion strength as claimed. Dependent Claims 63, 64, 65, 66, 67, and 68 recited the peel adhesion between the successive sheets being at least 150, 200, 250, 300, 400, and 500 g, respectively,

when the sheets are pulled laterally at 180 degrees. In marked contrast, the Kaye '819 Patent reaches a "low-tack repositionable adhesive." See column 2, lines 66-67 (emphasis added). Thus, the Kaye '819 Patent teaches away from the claimed high-strength peel adhesion strength.

Nor does the secondary reference – the James '012 Patent – render the claimed invention obvious. In order to make out a prima facie case of obviousness, the Patent Office must (1) determine the scope and contents of the prior art, (2) ascertain the differences between the prior art and the claims in issue, (3) determine the level of skill in the art, and (4) evaluate any evidence of secondary considerations. Thus, to establish a prima facie case of obviousness, three basic criteria must be met. First, each and every claim limitation must be taught or suggested by the prior art. Second, there must be some suggestion or motivation to one skilled in the art to modify the references or to combine their teachings. Lastly, there must be a reasonable expectation of success in combining the references to achieve the claimed combination. Equally important, to support combining references, evidence of a suggestion, teaching or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad conclusory statements about the teaching of the references. In re Dembiczak, U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). There must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2d 1313, 13717 (Fed. Cir. 2000).

Applying these principles to the present application, it is clear that a prima facie case of obviousness had not been made as to the amended claims. There is nothing in either the Kaye '819 Patent or the James '012 Patent – either alone or in combination – that would teach or suggest using a stack of flexible sheets as a recreational toy. The James '012 Patent is limited to a helical coiled spring toy, and has nothing to do with repositionable adhesive sheets commonly

used in the office setting. Applicant respectfully submits that when motivated to provide a toy for amusement to the user, one skilled in the art would not be motivated to look to office products, such as repositionable adhesive notes as disclosed in the Kaye '819 Patent. That is, "the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." In re Oetiker, 997 F.2d 1443, 1445 (Fed. Cir. 1992).

The James '012 Patent actually teaches away from the claimed invention in at least two respects. First, the James '012 Patent is limited to a helical coiled spring toy having a hollow interior. The James '012 Patent emphasizes the small radial cross section or width 17 of the spring (see column 1, lines 33-47 and column 2, lines 26-32). There is nothing in the James '012 Patent to suggest that the recreational toy could comprise sheets having first and second major surfaces as claimed. Second, the James '012 Patent states very generically that the toy could be manufactured from "various materials," and notes that the best results are obtained using spring steel (S.A.E.1040 to S.A.E. 1095).¹ See column 2, lines 43-47. Thus, nothing in the James '012 Patent teaches or suggests a recreational toy comprised of a stack of flexible sheet material as claimed (e.g., paper, vellum, or plastic film).

In short, the prior art teaches only using a stack of flexible sheets as a notepad. The claimed method involves the use as a recreational toy. The dependent claims emphasize the high peel adhesion of the pad, as well as the specific semi-circular or arcuate form. In view of the foregoing amendment and remarks, it is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the

¹ Presumably, these "S.A.E." numbers refer to the type of steel used using a designation system developed by the Society of Automotive Engineers. See generally <http://www.engineershandbook.com/Tables/carbonsteelalloys.htm>.

Examiner have any further questions or comments that need be addressed in order to obtain allowance, he is invited to contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

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